

B3
Cont.
determine a folder in which the document will be stored,
based on the notification.

REMARKS

Claims 1, 3-5 and 8-61 remain in this application. Claims 1, 4, 5 and 9-14, the independent claims, have been amended to define still more clearly what Applicants regard as their invention, in terms which distinguish over the art of record.

The Office Action Was
Improperly Made Final

In the Office Action mailed August 6, 1998, Claims 4, 10 and 13 were allowed. In the Amendment dated January 6, 1999, those three claims were amended, but as to formal matters only. For at least this reason, it was improper for the Office to make the outstanding Office Action final. MPEP § 706.07(a) provides, in part:

"[S]econd or any subsequent actions on the merits *shall* be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). [emphases added]"

Thus, the Examiner is permitted to make a second Action, rejecting claims that were allowed in the first Action, if: (i) the rejection was necessitated by amendments made by the applicant; or (ii) if the rejection is based on prior art submitted by the applicant in a proper Information Disclosure Statement after issuance of the first Action and before issuance of the second. Neither of those situations exists in the present case.

First, as noted above, the only changes made to the allowed claims were purely formal, and certainly did not "necessitate" the new rejection. (If the Examiner disagrees with this statement, she is requested to explain exactly how the changes to those claims resulted in a change of scope, and --even if (for argument's sake) they did-- why she was entitled to enter a final rejection of them on newly-cited art.)

Second, the newly-entered rejections of the claims in question (Claims 4, 10 and 13) are all based on prior art newly cited by the Office, not by Applicants.

Thus, there was no basis on which the Examiner was allowed to make the outstanding Action final, and the finality of that Action must be vacated.

PLEASE NOTE: In the event the Examiner, after careful consideration of this point, does not agree that the finality of the outstanding Action should be vacated and a new Action issued (assuming the case is for some reason not in condition for allowance), then she is requested to treat this paper as a Petition to the Commissioner for the exercise of supervisory authority, under 37 C.F.R. § 1.181(a)(3), and to forward this paper and the file to the appropriate official for decision. In such event, no fee for such petition is believed to be due, but if the Office disagrees, any fee due should be charged to Deposit Account 06-1205. (A duplicate copy of this paper is submitted herewith.)

Response to the Office Action

Claims 1, 3, 5, 8-34 and 39-61 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,832,470 (Morita et al.). Claims 4 and 35-38 were rejected under Section 102(e) as being anticipated by U.S. Patent 5,745,893 (Hill et al.).

Applicants have carefully studied the prior art and the reasoning set forth in the Office Action, but find themselves entirely unable to agree with the correctness of

either rejection. Notably, Applicants submit that there is a complete difference of roles of the notification procedure as between the two cited patents and claims rejected over those patents.

The purpose of the aspects of the invention set forth in the respective independent claims, is to determine a folder to store documents in, and to base the determination on the user's intention. In order that the user may easily determine the best folder from among candidate folders, notifying means and a step of providing notification, recited in the various independent claims, provide the supporting function of providing the user with information as to which of the folders is the most appropriate place to store the documents that are currently to be stored. The folder information provided by this means and this step is based on results of a selection or a calculation function, as set forth in the respective independent claims.

More specifically, independent Claim 1 is directed to a document processing system that has a means for retaining a plurality of folders each for storing at least one document, and a means for selecting at least one candidate folder suitable for retaining a new document, by

comparing a feature of the new document with an average of features of documents stored in a folder among the plurality of folders. The apparatus also has means for providing notification of the candidate folder selected by said candidate folder selecting means, in order that an operator can determine a folder in which the document will be stored, based on the notification.

Independent Claim 4 is directed to a document processing system that has a means for judging a similarity degree between document information and a plurality of sets of information of documents stored in a folder, and a means for calculating a similarity order of a plurality of folders in accordance with the similarity judged by the judging means. The apparatus also has a means for providing notification of the similarity order of the plurality of folders calculated by the similarity order calculating means, in order that an operator can determine a folder in which the document will be stored, based on the notification.

Independent Claim 5 is directed to a document processing system comprising a means for retaining a plurality of folders, each for storing a plurality of sets of document information, and a means for selecting at least one

folder from among the plurality of folders based on a number of sets of document information containing a keyword inputted as a search condition. Also provided is a means for providing a notification of the folder selected by the folder determining means, in order that an operator can determine a folder in which the document will be stored, based on the notification.

Claims 9-11 and corresponding method claims, and Claims 12-14 are corresponding memory-medium claims.

In contrast to the role of the notification means in Claims 1, 4 and 5 (and the role of the notifying step in Claims 9-14), the notification in *Morita* and *Hill* which is cited by the Examiner as allegedly being the same, is actually quite different from what is recited by Applicants. Notification in the above claims includes providing a user with information about folders, so that the user can determine where to store one or more documents. Notification in *Morita* and in *Hill*, in contrast, has to do with the structure of entire folders, and -- importantly-- is independent of the contents of any documents which may already be in those folders. Using any of the structures and methods set forth in the independent claims above, the user